



UNITED STATES PATENT AND TRADEMARK OFFICE

JO
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,687	02/10/2004	John R. Snoonian	VPI/01-09 US	9163
27916	7590	11/14/2005	EXAMINER	
VERTEX PHARMACEUTICALS INC. 130 WAVERLY STREET CAMBRIDGE, MA 02139-4242			DAVIS, ZINNA NORTHINGTON	
		ART UNIT	PAPER NUMBER	
		1625		

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/775,687	SNOONIAN ET AL.
	Examiner	Art Unit
	Zinna Northington Davis	1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 9 August 2005.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,3-14, 16-27, 29-40, 42-53 and 55-64 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) _____ is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) 1,3-14, 16-27, 29-40, 42-53, and 55-64 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	6) <input type="checkbox"/> Other: _____.

Election/Restrictions

1. Claims 1, 3-14, 16-27, 29-40, 42-53, and 55-64 are pending.
2. This action is response to the Amendment filed August 9, 2005.
3. Upon consideration of the claimed invention, this examiner finds that the claimed subject matter is drawn to multiple and independent inventions.
4. As such, restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 and 3-13, drawn to a process for producing a diaryl amine compound of formula (I) wherein Ar₁ and Ar₂ represent aryl rings.
 - II. Claims 1, 3-14, 16-27, 29-40, 42-53, and 55-64, drawn to a process for producing a diaryl amine compound of formula (I) wherein one member of Ar₁ or Ar₂ represents a heteroaryl ring.
5. Inventions II and I are related as process of making a chemical compound of formula (I). The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process. See Rewcastle et al (Reference, C5, cited by Applicants).
6. This application contains claims directed to the following patentably distinct species of the claimed invention: Ar₁ and Ar₂.

The ring system and radicals within the definition Ar₁ and Ar₂ are diverse in scope. A prior art reference, which anticipates one member such as phenyl under 35 U.S.C. 102, would not render obvious another member such as pyridinyl under 35 U.S.C. 103. Accordingly, the ring systems and the radicals are independent and patentably distinct.

7. Applicant is required under 35 U.S.C. § 121 to elect **a single disclosed species for prosecution** on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. If the preferred group is a method of use, a single disclosed disease state should be elected. Currently, claim 1 is generic.

8. It should be remembered that the purpose of an election of species requirement is to simplify the search and issues considered during prosecution, and that because this is so the ultimate allowance of a generic claim will encompass all additional species within the scope of the allowed genus. Stated alternatively, the purpose of an election of species requirement, as opposed to a restriction between claim groups, is to reduce the burden on the examiner during prosecution only; a full search is merely postponed until allowance of the generic claim.

9. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. §1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention.

10. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

11. A telephone call was made to Ms. Karen Brown on November 7, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

12. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

13. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna N. Davis whose telephone number is 571-272-0682. The examiner can normally be reached on M-F.

15. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Zinna Northington Davis
Primary Examiner
Art Unit 1625